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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213005
Party	Plaintiff Universal Protein Supplements Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Universal Protein Supplements Corporation,

Opposer,

v.

N.V.E., Inc.,

Applicant.

Serial No. 85/896,474

Opposition No. 91213005

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UNIVERSAL NUTRITION’S MOTION TO STRIKE AFFIRMATIVE DEFENSES

Opposer, Universal Protein Supplements Corporation (“Universal Nutrition”), through its counsel, Marshall, Gerstein & Borun LLP, requests that the Board strike certain of Applicant, N.V.E., Inc.’s (“NVE”) affirmative defenses. In support, Universal Nutrition states that:

1. NVE answered the opposition in this matter on November 5, 2013. In its answer, NVE asserted 13 affirmative defenses.

2. Affirmative defenses must be pled in response to a pleading. Fed. R. Civ. P. 8(c), T.B.M.P. § 311.02(b). Such defenses must be pled in short and plain terms but with sufficient detail to give the plaintiff fair notice of the basis for the defense. *Id.*

3. Insufficient defenses or other redundant, immaterial, impertinent, or scandalous matter may be stricken from a pleading on the Board’s initiative or on motion. Fed. R. Civ. P. 12(f), T.B.M.P. § 506.01.

4. A defense that is merely conclusory and without sufficient facts as to provide the basis for the defense and fair notice to the plaintiff will be stricken by the Board. *See, e.g., Veles Int’l, Inc. v. Ringing Cedars Press LLC*, Consolidated Opp. Nos. 91182303 and 91182304 (T.T.A.B. Jun. 2, 2008) (striking, on its own motion, Applicant’s affirmative defenses of waiver,

estoppels, and unclean hands as legally insufficient without factual support). *See also Reis Robotics USA, Inc. v. Concept Indus., Inc.*, 462 F. Supp. 2d 897, 907 (N.D. Ill. 2006) (striking affirmative defenses of laches, estoppel, unclean hands, and related equitable doctrines pled without supporting facts as insufficient under Fed. R. Civ. P. 8(a)).

5. The following of NVE's affirmative defenses were insufficiently pled and should be stricken by the Board:

a. Collateral attacks on Universal Nutrition's rights—Affirmative Defense # 1: "Opposer cannot claim any ownership rights in the mark."

NVE's attack on Universal Nutrition's pleaded registration is insufficient without a counterclaim or separately filed petition to cancel. T.B.M.P. § 311.02; 37 C.F.R. § 2.106(b)(2)(i). *See Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1325 fn.3 (Fed. Cir. 2008) (stating that where invalidity of a pled registration is asserted, the Board requires a compulsory counterclaim).

By its affirmative defense, NVE clearly calls into question Universal Nutrition's rights in at least one of the many marks it asserted in the opposition (although the particular marks impacted by the defense are not specified). This is an attack on Universal Nutrition's registrations, yet NVE's answer was neither accompanied by a counterclaim or petition to cancel as mandated by the Board nor sufficiently supported by facts detailing why Universal Nutrition is without ownership of the registrations that bear its name. Since the defense was improperly pled, it should be stricken.

b. Assertions of knowing delay and detrimental reliance—Affirmative Defenses # 5, 12, and 13: "The Opposition is barred by the doctrine of estoppel,"

“Opposer has acquiesced in the use of Applicant’s mark by Applicant,” and “Opposer’s claims are barred in whole or in part by the laches doctrine.”

The basis of these defenses is “knowing delay,” the suggestion that Universal Nutrition waited too long to bring its opposition, thereby allowing NVE to rely on such inaction to its detriment. These defenses, however, are generally unavailable in opposition proceedings, where the relevant time period is not measured from the time that an applicant began use of the mark, but rather from when the mark published for opposition. *See Embarcadero Tech., Inc. v. Delphix Corp.*, Opp. No. 91197762 (T.T.A.B. Jan. 10, 2012). Any delay prior to publication is irrelevant since publication is the first point in time when an opposer may challenge registration of the mark. T.B.M.P. § 311.02(b). *See also Nat’l Cable Television Assoc., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1582 (Fed. Cir. 1991) (stating that measure for laches runs no earlier than publication for opposition, not knowledge of first use); *and Sunkist Growers, Inc. v. Smile Factory, LLC*, 2009 TTAB LEXIS 683, at *7 (T.T.A.B. 2009) (stating that time periods for laches and acquiescence do not begin until a mark is published for opposition). In *Ironman Magazine v. World Triathlon Corp.*, 2009 TTAB LEXIS, at *18 (T.T.A.B. 2009), the Board found laches not to apply since the notice of opposition was filed within the opposition period.

NVE cannot likewise claim any detrimental reliance on the actions of Universal Nutrition. Assertions of estoppel are available only to those prejudiced by the detrimental reliance on the actions of another; a party cannot claim estoppel based on the actions of a party with whom it has no privity. *See Castro v. Cartright*, Opp. No. 91188477 (T.T.A.B. Sept. 5, 2009) (striking asserted defenses of estoppel and acquiescence for failure to

plead specific facts establishing relationship with opposer and applicant's reliance on opposer's actions) (citing *Textron, Inc. v. The Gillette Co.*, 180 U.S.P.Q. 152, 154 (T.T.A.B. 1973). See also *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 U.S.P.Q. 2d 1789, 1797 (T.T.A.B. 2009) (stating that in an opposition, an estoppel defense must be linked to the registration of applicant's marks, not applicant's use of the marks). In *Castro*, the Board struck an estoppel defense, finding the pleading insufficient since facts that, if true, would establish detrimental reliance on the actions of the opposer were not pled.

As in *Castro*, NVE's answer makes bald claims without providing a factual basis on which it may claim that Universal Nutrition waited too long to oppose or that NVE selected its mark in reliance on Universal Nutrition's conduct. To the contrary, Universal Nutrition filed its notice of opposition within the proscribed opposition period. In the cited *Nat'l Cable, Sunkist Growers, Castro*, and *Panda Travel* cases, the Board struck laches, estoppel, or acquiescence defenses as unavailable when the opposition had been timely filed. Additionally, even if valid, NVE's defenses as pled omit the required factual support necessary to support claims of laches, acquiescence, or estoppel. NVE's affirmative defenses are thus insufficient legally or factually to place Universal Nutrition on notice.

c. Assertions of impropriety—Affirmative Defense # 6: “Opposer's claims are barred in whole or in part by the unclean hands doctrine.”

NVE's claim of unclean hands is a bald, conclusory statement that is improper and should be stricken. Unsupported allegations of unclean hands have been repeatedly stricken by the Board. See, e.g., *Veles Int'l, Inc. v. Ringing Cedars Press LLC*,

Consolidated Opp. Nos. 91182303 and 91182304 (T.T.A.B. Jun. 2, 2008); *and Reis Robotics USA, Inc. v. Concept Indus., Inc.*, 462 F. Supp. 2d 897, 907 (N.D. Ill. 2006). Moreover, unclean hands, as a type of fraud, carries a heightened pleading standard and must be pled with particularity. *See* T.B.M.P. § 311.02(b) (imposing Fed. R. Civ. P. R. 9(b) pleading standard for pleading of fraud defenses); 37 C.F.R. § 2.106(b)(1); *and Cent. Admixture Pharm. Servs. v. Advanced Cardiac Solutions*, 482 F.3d 1347, 1356 (Fed. Cir. 2007) (requiring defenses concerning inequitable conduct to be pled with particularity).

NVE's assertion of unclean hands is a bald claim of impropriety devoid of even the baseline short and plain factual support required by Fed. R. Civ. P. 8(c) and T.B.M.P. § 311.02(b). Since the claim does not meet requirement of Fed. R. Civ. P. 8(c) or the heightened pleading standard of Fed. R. Civ. P. R. 9(b), it must be stricken as insufficiently pled.

d. Attacks on sufficiency of the opposition—Affirmative Defense # 11: “The opposition fails to state a claim entitling the Opposer to relief in that the respective marks are so different in look, sound and meaning.”

A defense of failure to state a claim is not a proper affirmative defense at all, but rather an assertion that the opposition itself is invalid. *See, e.g., Castro v. Cartright*, Opp. No. 91188477 (T.T.A.B. Sept. 5, 2009) (striking affirmative defense of failure to state a claim where opposer had standing and properly asserted claim of likelihood of confusion). A valid claim is stated if facts are alleged that would, if proven, establish (1) the opposer's standing and (2) a valid ground for opposing the registration of the mark. *Id.* An opposer's motion to strike the defense of failure to state a claim effectively tests the sufficiency of the opposition. *Id. See also Embarcadero Tech., Inc. v. Delphix Corp.*,

Opp. No. 91197762 (T.T.A.B. Jan. 10, 2012) (striking affirmative defense of failure to state a claim since opposition pled facts which, if true, would entitle the opposer to the relief sought).

In its opposition, Universal Nutrition alleged sufficient facts to provide notice of the marks in which it claims priority based on both common law use and federal registration. (Not. of Opp. ¶¶ 7-20.) Similarly, the opposition alleges facts that give NVE adequate notice of the claims of likelihood of confusion, (*id.* ¶¶ 28-30), false suggestion of connection, (*id.* ¶¶ 31-33), and commercial disparagement, (*id.* ¶¶ 34-35). These facts, demonstrate Universal Nutrition's personal interest in the outcome of the proceeding and put NVE on notice of the claims against which it must defend. Notably, NVE's affirmative defense does not address which of the counts of the opposition fail to state a claim but simply makes a boilerplate assertion of insufficiency.

As in *Castro* and *Embarcadero*, since the opposition establishes both Universal Nutrition's standing and valid claims as to each count, NVE's affirmative defense must be stricken.

WHEREFORE, Universal Nutrition asks that the Board strike Applicant's aforementioned affirmative defenses as factually or legally insufficient.

Respectfully submitted,

Universal Protein Supplements Corporation



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November 27, 2013

CERTIFICATE OF SERVICE

I certify that this Motion to Strike was served on the applicant on November 27, 2013, by mailing a copy by first class mail, postage prepaid, to its attorney of record, Brian M. Gaynor, Nicoll Davis & Spinella LLP, 95 N Route 17 S, Suite 316, Paramus, NJ 07652.



Matthew Ciesielski